

Obviousness Type Double Patenting

All claims have been rejected under the doctrine of obviousness-type double patenting over copending application USSN 10/659,090. In consideration of the allowance of USSN 10/659,090, a terminal disclaimer is filed herewith.

Rejection Under 35 U.S.C. §101

The Examiner rejected the claims, stating that the disclosed invention is inoperative and therefore lacks utility, asserting that “the instant compositions cannot exist according to conventional scientific theory.” Applicant respectfully disagrees. While not bound by the theory, the Applicant has provided substantial data and evidence that supports the conclusion that the claimed compositions are characterized by a modification to the composition’s electronic state and the compositions possess the characteristics described in the claims. This data has been confirmed by third parties. As established by the evidence presented in the specification that the compositions possess a number of physical properties (altered magnetism, ductility, resistivity, reactivity, etc.), the claimed compositions of matter are obviously suitable for a variety of utilities.

It is noted that very similar claims have been allowed in the copending application, USSN 10/659,090 where a similar rejection has been withdrawn. Thus, it is apparent that the subject matter of the claims is not inoperative and does not lack utility.

Applicant respectfully requests that the rejection under 35 U.S.C. §101 be withdrawn.

Rejection Under 35 U.S.C. §112, First Paragraph

The Examiner rejected the claims stating that the specification does not describe the invention or enable one of ordinary skill in the art to make or use a composition of matter that is distinguishable from its naturally occurring state, in that it would require undue experimentation to do so.

Applicant respectfully traverses. Applicant has presented 14 working examples with detailed XRF analysis that showed each of the manufactured ingots contains a different elemental signature from its corresponding natural occurring metal state. There is no basis to conclude that the result is explained by impurities introduced into the process and/or undetected in the starting materials or from transmutation of metals. The manufactured ingots are still the same starting metal, but exhibit different electronic state scans from their original precursor in the GMS, XRF, PIXE, and GDOES analyses. Confirmation of these analyses from third party companies has been submitted. No more is required under the law.

The Office action on page 3 criticizes the Declarations made by Dr. Nagel. Given the withdrawal of the rejection in USSN 10/659,090 based on the same declaration, it is not seen how this criticism can be maintained. A copy of the Supplemental Declaration filed on August 16, 2006 in the '090 application is enclosed herewith for the Examiner's convenience.

It is noted that this rejection has also been withdrawn in USSN 10/659,090. Claim 1 differs from those allowed claims in that (1) the composition is not limited to silicon and transition metals and (2) the limitation that the product be made by a reiterative process has been deleted. With respect to the scope of the elements claimed, given the very divergent number of elements where data has been provided, including metals other than transition metals, such as alkali metals, silicon and aluminum, there is no logical basis for restricting the claims to transition metals and silicon. Applicants have refuted any argument that the observed phenomenon is unique to transition metals. There is no scientific basis presented to conclude that other elements of the periodic table, particularly metals, could not be similarly modified. Nonetheless, it is noted that Claims 6-9 and 13 are limited to transition metals and silicon and, thereby, avoid this basis for rejection.

With respect to the requirement that the claims be limited to the process by which it is made, there is no legal authority presented that supports the proposition that a claim to a product must be limited to the process described in the specification which enables

the claimed products, even in an unpredictable art. That is, it is not in dispute that the specification enables the manufacture of the claimed compositions (at least with respect to the transition metals and silicon), employing such an iterative process (see Claim 12). Thus, it is not in dispute that the specification teaches at least one enabled process. No more is required under the law. In fact, the USPTO did not require the claims of US Patent 6,572,792, a parent application, to be so limited. Thus, the rejection, to the extent that it is inferred here by the requirement to include the limitations of the present Claim 12 into the claims of USSN 10/659,090, is improper.

Based upon the breadth of the exemplification provided to date, it is believed that Applicant has satisfied his burden for enabling the full scope of the claims. The USPTO has failed to meet its burden in establishing why the specification is not enabling for the scope of the claims.

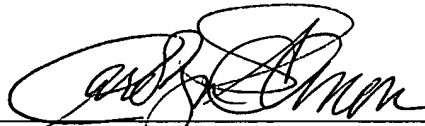
Withdrawal of the rejection is respectfully requested.

### **Conclusion**

In view of the above amendments and remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned at (978) 251-3509.

Respectfully submitted,

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